

REMARKS

The following remarks are prepared in response to the Office Action of January 31, 2006. Claims 28-31 and 34-54 are pending in this application, after entry of this amendment. Independent claims 28, 40 and 46 are amended herein. Claims 32 and 33 have been cancelled. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

The Office Action contends that claims 28-32 and 34-45 are anticipated under 35 U.S.C. §102(b) by *Gavette* (*Gavette* reference, U.S. Patent No. 6,321,095). Applicant respectfully traverses this contention.

The invention relates to a transceiver that allows for two-way private communication without the use of an intermediate network. The transceiver can be an initiator or a recipient of the communication. The transceiver has a control device or processor configured, as an initiator transceiver, to transmit call initiate information having at least one recipient identification code retrieved from memory, to at least one recipient transceiver, each identified by its own identification code. Each recipient transceiver determines whether the recipient identification code is identical to its identification code, and transmits acknowledgement information to the initiator transceiver if they are identical. The initiator transceiver receives acknowledgement information from the recipient transceiver selected from the at least one recipient transceiver that has an identification code that is identical to the recipient identification code, and transmits data to the recipient transceiver.

Amended claim 28 recites “[a] half-duplex communication device identified by an initiator identification code comprising:

a control device to

[A] receive an identification code stored in memory,

[B] transmit the initiator identification code and the identification code directly to a transceiver identified by a transceiver identification code, without the use of an intermediate network, and

[C] receive acknowledgment information in response to the transceiver determining that the identification code matches the transceiver identification code.”

The control device receives an identification code that is stored in memory (paragraph 31, lines 10-11). Specifically, “the user operating in the ISeekU mode may input using the keypad 115 or select from a menu using the up and down buttons 150, 155, the recipient identification code (or recipient identification name) of the recipient transceiver(s) to contact (S-530) . . . [that is] stored in the memory module of the initiator transceiver 100 (S-535)” (paragraph 31, lines 5-11).

The *Gavette* reference is primarily concerned with providing communication between a first or initiator (PBS) and a second or recipient (TMS) mobile station. The communication is established by “1) looking for the second mobile station in active circuits and by 2) attempting to attract the attention of the second mobile station by ‘paging’ the second mobile station” (col. 6, lines 53-56). The *Gavette* reference explains that “[i]n general, mobile stations locate other mobile stations by examining circuits” (col. 7, lines 15-17). To look or locate the second mobile station, the first mobile station “PBS 102 exhaustively examines all available circuits in all available conduits to locate and determine the state of [second mobile station] TMS 104 (col. 7, lines 31-33). Specifically, the first mobile station (PBS 102) examines the broadcast channel (BCCH) slot looking for the mobile station identifier (MSID) of the second mobile station (TMS 104) to determine whether TMS 104 is currently participating in a communication session, and if

not, would transmit a page on the random access channel (RACH) slot of each active circuit (col. 7, lines 34-37). Accordingly, the MSID of the second or recipient mobile station is transmitted by the second mobile station on the BCCH slot, which is then received by the first or initiator mobile station that is exhaustively examining all available circuits for MSIDs.

In contrast to amended claim 28, the *Gavette* reference does not disclose, teach or suggest that the MSID is stored in memory. Rather, the *Gavette* reference discloses that the MSID is received by the initiator mobile station via the broadcast channel (col. 7, lines 34-37). The MSID of the recipient mobile station is transmitted by the second or recipient mobile station on the BCCH slot, which is then received by the first or initiator mobile station that is exhaustively examining all available circuits for MSIDs (col. 7, lines 31-33). The first or initiator mobile station uses this received MSID from the BCCH slot to establish communication with the second or recipient mobile station.

Furthermore, claim 28 recites a transceiver 100 that utilizes a two-way half-duplex communication system (paragraph 24, lines 1-2). In contrast, the *Gavette* reference touts two-way radios that support half-duplex operation as a “drawback” because “only one user can talk at a time” (col. 1, lines 32-35). The *Gavette* reference assigns frequency slots, identified as a broadcast channel (BCCH), a traffic associated control channel (TCH) and a dedicated control channel (DCCH) for communication with the recipient mobile stations (TMS) (col. 8, lines 33-40). This allows for m-duplex, simultaneous bidirectional communication between two or more mobile stations, which is distinct and different from the half-duplex communication system recited in claim 28 (col. 21, lines 6-9). Hence, not only does the *Gavette* reference fail to disclose, teach or suggest the claimed invention, it also teaches away from the invention. Therefore, the *Gavette* reference does not anticipate claim 28.

Claims 29-31 and 34-39 depend from claim 28. Thus, these claims are patentably distinct from the *Gavette* reference for the same reasons advanced above with respect to claim 28. Moreover, independent claims 40 and 46, and their dependant claims, are also patentably distinct from the *Gavette* reference for the same reasons advanced above with respect to claim 28.

The Office Action also contends that claim 46 is obvious under 35 U.S.C. §103(a) by a combination of *Gavette* in view of *Fumarolo et al.* (*Fumarolo* reference, U.S. Patent No. 6,366,782). Applicant respectfully traverses this contention.

It should be noted that the burden of establishing a *prima facie* case of obviousness lies with the Patent Office. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) (stating: “The PTO has the burden under section 103 to establish a *prima facie* case of obviousness”). To establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations. See *MPEP* §§ 2142-43.

As discussed above, the *Gavette* reference fails to disclose, teach or suggest the features recited in amended claim 28. Furthermore, independent claim 46 recites an initiator transceiver that transmits using the available channel and a recipient transceiver that transmits using the available channel. Hence, the two transceivers transmit using the same channel resulting in half-duplex communication. By contrast, the *Gavette* reference assigns separate slots to PBS 102 and TMS 104 to transmit data to each other simultaneously (col. 8, lines 38-40).

The *Fumarolo* reference does not remedy the deficiencies of the *Gavette* reference. The *Fumarolo* reference was cited simply for the teaching of a half-duplex communication system (col. 6, lines 1-5). However, the *Fumarolo* reference cannot be combined with the *Gavette*

reference because the *Gavette* reference teaches away from using a half-duplex communication system. “A reference teaches away only when a person of ordinary skill, upon examining the reference would be discouraged from following the path set out in the reference, or would be led in a direction different from the path that was taken by the applicant.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). The *Gavette* reference discloses m-duplex communication that allows “simultaneous bidirectional exchange of information between two or more participants” (col. 21, lines 6-13). The *Gavette* reference emphasizes two-way radios that support half-duplex operation as a “drawback” because “only one user can talk at a time” (col. 1, lines 32-35). Hence, the *Gavette* reference discourages a person of ordinary skill in the art from using a half-duplex communication system because of its purported drawbacks. Therefore, the *Gavette* reference teaches away from using half-duplex communication, and accordingly, the *Fumarolo* reference cannot be combined with the *Gavette* reference. Furthermore, adding the teaching of the *Fumarolo* reference into the *Gavette* reference does not disclose, teach or suggest the combination of features recited in amended claim 28. This is because neither reference, solely or in combination, discloses, teaches or suggests a control device to receive an identification code stored in memory. Hence, the *Fumarolo* reference does not satisfy the deficiencies of the *Gavette* reference.

Applicant accordingly submits that claims 28, 40 and 46 more than adequately distinguished over any combination of the references of record by the presently pending claims, and is worthy of patent protection.

If the Examiner believes a telephone interview will assist in the prosecution of this application, the undersigned attorney can be contacted at the listed phone number.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 11, 2006.

By: Lisa Holstein



Signature

Dated: April 11, 2006

Very truly yours,

SNELL & WILMER L.L.P.



Ketan S. Vakil
Registration No. 43,215
600 Anton Boulevard, Suite 1400
Costa Mesa, California 92626-7689
Telephone: (714) 427-7405